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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,902	01/06/2006	Stephen Berman	82RK102	7189
42173	7590	01/07/2008		
LAW OFFICE OF RICHARD B. KLAR 145 WILLIS AVENUE MINEOLA, NY 11501			EXAMINER HUYNH, KHOA D	
			ART UNIT 3751	PAPER NUMBER
			MAIL DATE 01/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,902

Applicant(s)

BERMAN, STEPHEN

Examiner

Khoa D. Huynh

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8-13 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohlbein et al. (2005/0186014).

Regarding claim 8, the Hohlbein et al. reference discloses an instrument (Figs. 8 & 9). The instrument includes a barrel (constituted by the interior space) having one end (constituted by the left portion as shown in Fig. 8) that is adjacent a tip (constituted by the portions about **14, 22** as shown in Fig. 1) of said instrument, the barrel having bladders (at 40) build into the barrel, and a pumping mechanism (Fig. 9) for pumping air into the bladders to facilitate better gripping by a user at the one end of the instrument, wherein the pumping mechanism includes an airway passage (at 82) and a one-way valve (at 84) for air to enter from the pumping mechanism into the bladders. In addition, the instrument and its tip are capable of being used as a writing instrument for writing on a surface such as a sand surface. *Also, as shown in Figure 1, the tip extends outside of*

the barrel (constituted by portion 14) and past the bladder (constituted by portion 22).

Regarding claim 9, as schematically shown in Fig. 9, the pumping mechanism appears to be an integrated clicker (at 74) and a pump handle (constitute by the portion which housed elements 82, 86, 78).

Regarding claim 10, as schematically shown in Fig. 9, the pumping mechanism includes a pump handle (constitute by the portion which housed elements 82, 86, 78) that is separate from the clicker (at 74).

Regarding claims 11 and 12, as schematically shown in the cross-section of Fig. 9, the bladders are formed of material having a rubber-like property or a rubber material.

Regarding claim 13, a release mechanism (86) is located on the side of the instrument for release excess air.

Claim 17 recites limitations that are substantially identical to the limitations recited in claim 8 which has been rejected as discussed supra.

Response to Amendment

3. Applicant's amendment, filed on 11/23/2007, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

Response to Arguments

4. Applicant's arguments filed 11/23/2007 have been fully considered but they are not persuasive.

Art Unit: 3751

Applicant asserts that Hohlbein et al. does not teach a writing instrument with a writing tip *extending outside of the barrel and past the bladders*. See Remarks section, page 4-5. The examiner disagrees.

As stated in the above rejection, Hohlbein et al. instrument is capable of being used to write on a surface such as a sand surface using the tip of the instrument. *Also, as shown in Figure 1, the tip extends outside of the barrel (constituted by portion 14) and past the bladder (constituted by portion 22).*

Furthermore, even though Hohlbein et al. tip may have different structures from the tip used in the present invention, such alleged structural differences are not a germane since the claims do not recite limitations regarding the structures of the writing tip distinguished over the tip in the Hohlbein et al. reference.

In response to applicant's argument that the Hohlbein et al. reference fails to show *an ink cartridge including ink, wherein the ink cartridge having a tip...to dispense the ink from the cartridge (see Remarks section, page 5)*, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

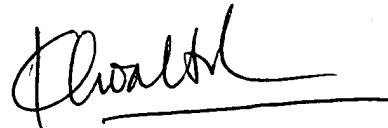
Also applicant's arguments filed on 11/23/2007 to the pending claims have been considered but are moot in view of the new grounds of rejection as discussed supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoa D. Huynh
Primary Examiner
Art Unit 3751